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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,579	12/03/2003	Poh C. Chua	BS99-219-CON	3455

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PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,579

Applicant(s)

CHUA ET AL.

Examiner

Jean A. Gelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44, 45, 48-52, 55-58 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44, 45, 48-52, 55-58, and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 9/05/06 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 44, 45, 48-52, 55-58, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto in view of George (US 5,214,789).

Regarding claims 44, 51, and 56, Yamamoto teaches a method for operating wireless devices in vehicles (sections 18-20) comprising: monitoring a relationship between a wireless device and a vehicle (sections 18-20, 48) by evaluating location information that specifies a location of the wireless device, that specifies a location of the vehicle, and that is generated by a location system to determine the relationship by (i.e., the system measures when the MS is in the

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range of a audio device in order to activate the hands-free mode, inherently location of the MS with respect to the car audio device be known prior to establish the BT radio link with the car device, sections 48, 59, 65, and 68); and enabling operation of the wireless device in a hands-free mode if the relationship satisfies a condition (i.e., when the mobile is in the vehicle, information can be transmitted in hands-free mode without making any operation, section 48).

Yamamoto does not specifically teach comparing the location of the wireless device to the location of the vehicle.

However, the preceding limitation is known in the art of communication. Wolfe teaches a computer reads the automatic vehicle locator to determine the location of the mobile radio when a transmission is to be initiated, the location of the mobile is compared to the geographic reference (col. 4, lines 51-67). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of George within the system of Yamamoto in order that the mobile station is tuned to the selected channel which corresponds to the zone in which it is located (e.g., selecting proper mode of function when inside of the vehicle as required in Yamamoto's reference)

Regarding claims 45, 60, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches wherein the relationship indicates that the device is located within the vehicle (section 48)

Regarding claim 48, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches comprises measuring a signal strength transmitted by the wireless device by a transceiver associated with the

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vehicle in addition to evaluation of location (for detection when to connect or disconnect the MS to AS, sections 58-59, determination when to assign the BT radio link to the car audio device is base on the location of the MS with respect to the car audio device, section 48).

Regarding claims 49, and 63, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches wherein the wireless device is a wireless telephone (MS is mobile telephone, section 48).

Regarding claim 50, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches wherein the enabling operation of the wireless device in a hands-free mode is performed by the wireless device (section 48).

Regarding claims 52, 57, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches wherein the determining is performed by a geonavigational positioning system (section 0094-0097).

Regarding claim 55, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches wherein the enabling is performed by a microprocessor that controls the wireless telephone (sections 13 and 48).

Regarding claim 58, Yamamoto in view of George teaches all the limitations above. Yamamoto further teaches wherein at least one of the location systems is a GPS receiver (sections 94-95, 103).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 6, 9, 11, and 14 of patent # 6,690,956 contains every element of claims 44, 45, 48-52, 55-58, and 63 of the instant application and as such anticipate claims 44, 45, 48-52, 55-58, and 63 of the instant application because the patent and the application are both directed to comparing the location of vehicle and the location of the wireless, and enabling handsfree mode if condition is satisfied.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double

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patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wolfe (US 6,778,068) teaches determining the vehicle position and the mobile communication terminal.

Kitao (US 2002/0032048) teaches on-vehicle handsfree system and mobile terminal.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

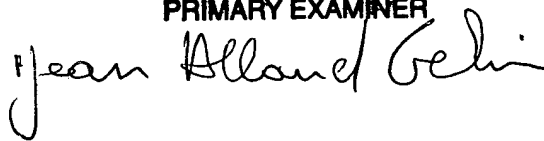
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Banks-Harold Marsha can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGelin
September 27, 2006

JEAN GELIN
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Jean Allard Gelin". The signature is written in black ink and is positioned below the printed name and title.